

REMARKS

We have amended claims 1 and 2 to make the corrections required by the Examiner, and have also amended claim 7 to make a corresponding correction. Also, we have added new claims 18, 19, and 20.

The Examiner has rejected independent claim 1 and claims 2, 4, 6, 9, and 10 dependent on claim 1 under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent 10-95495 to Sekikawa; has also rejected independent claim 1 and claims 2-4, 6 and 8-10 dependent on claim 1 under 35 U.S.C. 103(a) as being unpatentable over Swiss Patent 247,664 to Schlaepi in view of U.S. Patent No. 5,129,297 to Bussi; and has additionally rejected independent claim 1, and claims 2-4, 6, 8-10 and 12 dependent on claim 1 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,040,149 to Einhorn in view of Bussi.

Sekikawa, Schlaepi, and Einhorn all describe hangers that, like the hanger according to the present invention as claimed in claim 1, include a base having a supported surface adapted to be positioned along a generally vertical surface, and an opposite outer surface; an elongate peg having a longitudinal axis and first and second longitudinally spaced ends, a portion of which peg adjacent its first end is mounted on the base in a use position with the axis of said peg projecting away from said supported surface, at least a major portion of which peg adjacent its second end projects from the outer surface of the base. Also, the pegs described in these references have axially extending surface portions adapted to be positioned uppermost when the supported surface is positioned along a generally vertical surface. Additionally, like the embodiment of the hanger according to the present invention claimed in claim 2, the pegs described in Sekikawa and Schlaepi define sharp edges along their surface portions that in Schlaepi, (but not in Sekikawa) are defined by screw threads extending around the axis of the peg as is claimed in claim 3.

Unlike the hanger according to the present invention, however, the hanger described by Sekikawa is of a well known type used for supporting a number of clothes hangers engaged with garments such as the garment or coat illustrated in Figure 7 thereof and would necessarily be a large strong structure in order to be able to support such clothes hangers and garments. Normal

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sized sheets of paper pressed over the end of the hanger described by Sekikawa would be significantly destroyed by the opening that would be formed in them by the end of the hanger.

In contrast, the paper hanger according to the present invention as claimed in claim 1 is for supporting one or more sheets of paper, and the major portion of the peg on which the paper sheets are supported has a diameter of less than about 0.17 inch (0.43 centimeter) which is significantly smaller than the diameter of clothes hangers of the type described by Sekikawa so that the paper hanger according to the present invention is suitable for supporting sheets of paper but would not have sufficient size or strength to support a number of clothes hangers engaged with garments. It would not have been obvious to one skilled in the art of hangers to miniaturize a clothes hanger of the type described by Sekikawa for the purpose of making a paper hanger.

Also, unlike the hanger according to the present invention, the hanger described by Schlaepi has a tapered end portion 1 like that of a wood screw that is adapted to be embedded in a rigid object such as a picture frame (6), after which the hanger is supported in a fixed position on the rigid object in which it is embedded so that a barb (4) on its base can be pressed into a wall (7) and will then support along the wall (7) the rigid object (6) in which the hanger is embedded. The hanger described by Schlaepi is not suitable for supporting flexible objects such as sheets of paper which can not help maintain the barb (4) in engagement with the wall.

In contrast to the structure of Schlaepi, the paper hanger according to the present invention as claimed in claim 1 is for supporting one or more sheets of paper, and the major portion of the peg on which the paper sheets are supported has a generally uniform cross sectional area along its length. Sharp edges along that major portion as claimed in claim 2 can be defined by machine screw threads rather than wood screw threads, as is claimed in claim 3.

Additionally, unlike the hanger according to the present invention, the peg (67) on the hanger described by Einhorn with reference to Figure 17 has a smooth tapered periphery, projects upwardly (see column 8, lines 36-39 of Einhorn) with respect to the support surface (66) on its base (69) in order to retain an object about it, and is adapted to be embedded in a rigid object such as a picture frame (70) (see Figures 19 and 20 and column 8, lines 43-55 of Einhorn), after which the hanger is supported in a fixed position on the rigid object in which it is embedded so

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that a barb (68) on its base can be pressed into a wall and will then support the frame (70) along the wall in which the barb (68) is embedded.

In contrast, the paper hanger according to the present invention as claimed in claim 1 is for supporting one or more sheets of paper, and the major portion of the peg on which the paper sheets are supported has a generally uniform cross sectional area along its length, projects generally at a right angle with respect to the supported surface on its base, and only an axially extending surface portion of the peg restricts free movement of sheets of paper around the peg axially of the peg.

There is no teaching or suggestion in Sekikawa or in Schlaeppi or in Einhorn to use their pegs to support sheets of paper, nor to provide a peg for supporting the sheets of paper that projects generally at a right angle with respect to the supported surface on its base and has a major portion with a diameter of less than about 0.17 inch ( 0.43 centimeter) and a generally uniform cross sectional area along its length. There is no teaching or suggestion in Sekikawa or in Schlaeppi or in Einhorn that these features were recognized as result effective variables. For this reason, no basis exists for the Examiner's Conclusion that it would have been obvious to adapt these features based on "optimization of proportions in a prior art device" as a "design consideration". See in re Antonie, 559 F.2<sup>nd</sup> 618, 620, 195 USPQ 6, 8-9 (CCPA 1977). The Examiner's obviousness conclusion lacks the requisite suggestion for the proposed modifications as well as the requisite reasonable expectation that the proposed modifications would be successful. See In re O'Farrell, 853 F.2<sup>nd</sup> 846, 850-51, 7 USPQ2nd 1673, 1680-81 (Fed. Cir. 1988). Thus, the structure for a paper hanger recited in claim 1 is not made obvious by Sekikawa or by Schlaeppi or by Einhorn.

Nor is there any teaching or suggestion in Bussi to modify the structures of either Schlaeppi or Einhorn and thereby make obvious the present invention as claimed in claim 1. Bussi describes a "locator element" having a threaded end portion adapted to engage a structure, and a larger protruding pointed portion projecting from that threaded end portion that will pierce a construction panel pressed against it and then indicate along the construction panel the location of the structure with which its treaded end portion is engaged.

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With reference to combining the descriptions of Schlaeppi and Bussi the Examiner has suggested "It would have been obvious to one of ordinary skill at the time the invention was made to have modified the hanger" of Schlaeppi "by substituting the fastener/peg (3) of Bussi for the peg because one would have been motivated to provide a means for self-tapping into objects formed of metal as taught by Bussi." We are uncertain of what part of Bussi's structure the Examiner would substitute for what part of Schlaeppi's structure, or how self tapping into metal objects relates to forming paper hangers. The structures described by Schlaeppi and Bussi are for totally different purposes, neither is a paper hanger, and we find no teaching or suggestion in Bussi to modify the structure of Schlaeppi to provide a paper hanger having the structure claimed in claim 1.

With reference to combining the descriptions of Einhorn and Bussi the Examiner has suggested "Bussi discloses a member (Fig.3) comprising a fastener (3) including a machine screw threaded portion (at 3) having a uniform cross-section area along its length. It would have been obvious to one of ordinary skill at the time the invention was made to have modified the hanger of Einhorn by substituting the fastener/peg (3) of Bussi for the peg (67) because one would have been motivated to provide a means for self-tapping into objects formed of metal as taught by Bussi (col. 4, lines 50-55)." We are again uncertain of how self tapping into metal objects relates to forming paper hangers. The structures described by Einhorn and Bussi are for totally different purposes, neither is suitable for a paper hanger, and we find no teaching or suggestion in Bussi to modify the structure of Einhorn to provide a paper hanger having the structure claimed in claim 1. It is only the applicant's own disclosure that provides any teaching or suggestion for the combination of structural features recited in claim 1. The Examiner's obviousness conclusion is based upon impermissible hindsight rather than upon some teaching suggestion or incentive derived from the applied prior art.

Claim 1 should be allowed.

Claims 2 through 12 are dependent on claim 1, and thus are allowable for all of the reasons given above with respect to claim 1. Additionally, these dependent claims include further structural limitations that are not shown or suggested in the claimed combination by the cited art. For example, claim 2 recites that the axially extending surface portion of the peg

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defines closely spaced sharp edges that restrict free movement of sheets of paper around peg axially of the peg, whereas claim 4 recites that the peg is serrated to form peaks having those sharp edges, claim 5 recites that the peg includes a coating of abrasive granules that have those sharp edges, and claim 6 recites that the peg in the hanger according to the present invention has axially spaced transverse ridges providing sharp edges only on the axially extending surface portion. Claim 7 recites that the peg includes a coating of adhesive defining the axially extending surface portion of the peg that restricts free movement of sheets of paper around the peg axially of the peg.

The Examiner has rejected claim 5 (which recites that the peg includes a coating of abrasive granules) under 35 U.S.C. 103(a) as being unpatentable over Sekikawa in view of U.S. Patent No. 2,866,583 to Batts and further in view of U.S. Patent 5,690,561 to Rowland et al. (Rowland). As noted above, Sekikawa does not teach or even suggest a paper hanger for supporting one or more sheets of paper, nor does Sekikawa suggest such a paper hanger in which an axially extending surface portion on the peg restricts free movement of sheets of paper around the peg axially of the peg because of sharp edges provided by abrasive granules. Batts describes the use of sharp edges provided by abrasive granules on a clothes hanger to restrict slippage of clothes from around the hanger, whereas Rowland describes the use of sharp edges provided by serrations or abrasive granules on the face of a golf club to affect movement of a golf ball struck by the club. Sekikawa, Batts and Rowland describe structures from unrelated fields of art, none of which have anything to do with hangers for sheets of paper, and there is no teaching or suggestion in any of those references that would make obvious a paper hanger having the features claimed in claim 5.

The Examiner has rejected claims 7 under 35 U.S.C. 103(a) as being unpatentable over Sekikawa in view of Batts suggesting that Batts describes "an adhesive coating of abrasive granules (22)". Claim 7, however, recites that the peg includes a coating of adhesive (not abrasive granules) defining the axially extending surface portion of the peg that restricts free movement of sheets of paper around the peg axially of the peg. There is no teaching or suggestion of such use of a coating of adhesive in Batts.

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Claim 9 recites that a major portion of the peg adjacent its second end projects from said the outer surface of its base by a distance in a range of about 0.15 to 0.30 inch (0.38 to 0.76 centimeter); whereas claim 10 recites that feature together with the feature that the peg has a diameter of about 0.11 inch (0.28 centimeter). The Examiner has rejected these claims under 35 U.S.C. 103(a) as being unpatentable over Sekikawa or Schlaeppi in view of Bussi. Neither of these features is either taught or suggested by any of those references, however.

Dependent claim 12 recites that a portion of the peg adjacent its first end is mounted on the base for movement of the peg between its use position and a storage position with the peg extending along the outer surface of the base. The Examiner has rejected claim 12 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,040,149 to Einhorn in view of Bussi.

Einhorn, like Bussi, has nothing to do with hangers for sheets of paper. While the hanger of Figure 34 in Einhorn has a hook (143) movable between two positions with respect to a base (140), there is not the faintest suggestion in Bussi that a peg of the type claimed in claim 12 should be substituted for that hook, since the structures described by Einhorn and Bussi are for totally different purposes, and neither is suitable for a paper hanger.

Independent claim 13 recites the combination of at least one sheet of paper with a through opening, and a hanger for the sheet of paper, which hanger comprises a major portion of a peg projecting from a base that has a diameter of less than about 0.17 inch (0.43 centimeter), a generally uniform cross sectional area along its length, and an axially extending surface portion defining closely spaced sharp edges, which portion of the peg extends through the opening in the sheet of paper, the surface portion defining the sharp edges being adapted to be positioned uppermost when the supported surface is positioned along a generally vertical surface so that only the sharp edges restrict movement of the sheet of paper around said peg axially of the peg. The Examiner has rejected claim 13 (together with claims 15 and 17 dependent on claim 13) under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,430,301 to Venus in view of Sekikawa.

Venus is the only references cited by the Examiner against the claims in this application that describes a hanger for sheets of paper. The structure of the hanger described by Venus, however, is significantly different than the structure of the paper hanger claimed in claim 13. As

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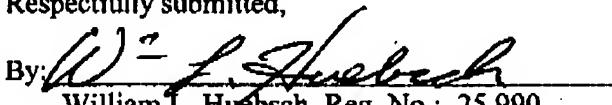
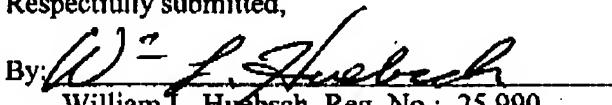
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noted by the Examiner, Venus does not describe a peg that is mounted at a right angle with respect to a supported surface or a surface portion defining closely spaced sharp edges. There is no teaching or suggestion in Sekikawa to modify the structures described by Venus to provide those structures. The clothes hanger described by Sekikawa has nothing to do with hanging sheets of paper, and does not describe or suggest a peg having a diameter of less than about 0.17 inch (0.43 centimeter). Thus, claim 13 should be allowed together with claims 15 and 17 dependent on claim 13.

Claims 14 and 16 are dependent on claim 13 and are thus allowable for all of the reasons given above with respect to claim 13. Additionally, these claims recite further structural limitations that are not shown or suggested by the cited art; specifically, claim 14 recites that the sharp edges of the surface portion are defined by machine screw threads, whereas claim 16 recites that the peg includes a coating of abrasive granules that have those sharp edges. The Examiner has added Schlaeppi to the combination of Venus and Sekikawa in rejecting claim 14; and has added Rowland et al to the combination of Venus and Sekikawa in rejecting claim 16. As noted above, however, the structure described by Schlaeppi has nothing to do with a hanger for sheets of paper, provides no teaching or suggestion to modify the structures of Venus or Sekikawa, and thus would not make obvious the threads claimed in claim 14. In any event, the threads described in Schlaeppi are tapered woodscrew threads, whereas claim 14 recites machine screw threads which are not tapered. Also for the reasons stated above with respect to claim 5 there is no teaching or suggestion in Rowland et al to use abrasive granules to form sharp edges on the claimed surface portion of a paper hanger. Thus claims 14 and 16 should also be allowed.

Reconsideration in view of the amendments and remarks in this amendment, withdrawal of the outstanding rejection, and allowance of the pending claims are respectfully requested.

Respectfully submitted,

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